

REMARKS

Claims 9-12 and 20-21 are presently pending, and claim 23 is added. Claims 1-4 and 13-15 are withdrawn from consideration. Claims 5-8, 16-19, and 22 are cancelled without prejudice.

Claims 9, 20, and 23 were rejected under 35 U.S.C. 103(a) as being obvious from the combination of Piazza in view of Vartti, and further in view of Lee.

Piazza indicates that "The compressed macroblock is then loaded into cache memory 810 (paragraph 0066). Cache memory 810 is the claimed 'local buffer'." Office Action at 3. However, Piazza does not teach that "compressed video data stored in the local buffer, wherein the portion comprises a macroblock row". However, the Office Action indicates that Lee discloses "a macroblock row", and that it would be obvious to combine Piazza, and Vartti, with Lee.

The legal concept of *prima facie* obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence in each step of the examination process. See *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976); *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972); *In re Saunders*, 444 F.2d 599, 170 USPQ 213 (CCPA 1971); *In re Tiffin*, 443 F.2d 394, 170 USPQ 88 (CCPA 1971), *amended*, 448 F.2d 791, 171 USPQ 294 (CCPA 1971); *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968). The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

If, however, the examiner does produce a *prima facie* case, the burden of coming forward with evidence or arguments shifts to the applicant who may submit additional evidence of nonobviousness, such as comparative test data showing that the claimed invention possesses improved properties not expected by the prior art. MPEP 2142.

Office personnel should consider all rebuttal arguments and evidence presented by applicants. See, e.g., *Soni*, 54 F.3d at 750, 34 USPQ2d at 1687 (error not to consider evidence presented in the specification). *C.f.*, *In re Alton*, 76 F.3d 1168, 37 USPQ2d 1578 (Fed. Cir. 1996) (error not to consider factual evidence submitted to counter a **35 U.S.C. 112** rejection); *In re Beattie*, 974 F.2d 1309, 1313, 24 USPQ2d 1040, 1042-43 (Fed. Cir. 1992) (Office personnel should consider declarations from those skilled in the art praising the claimed invention and opining that the art teaches away from the invention.); *Piasecki*, 745 F.2d at 1472, 223 USPQ at 788 ("[Rebuttal evidence] may relate to any of the *Graham* factors including the so-called secondary considerations."). MPEP 2145.

Assignee respectfully submits that the use of "macroblock rows" provides unexpected results. In the present case, the combination of Piazza and Vartti differ from the present invention in that Piazza and Vartti do not teach "macroblock rows", but only a macroblock.

MPEG-2 uses variable length coding. In variable length coding, later symbols are data-dependent on earlier symbols. Accordingly, the later symbols cannot be decoded without the earlier symbols. To allow encoding starting at various intervals, MPEG-2 uses what are known as slices.

Slices can include several macroblocks. A variable length decoder cannot start with decoding a given macroblock that occurs in the middle of a slice.

However, according to the MPEG-2 standard, the first macroblock of a row is guaranteed to be the first macroblock of a slice. Therefore, by using macroblock rows, the variable length decoder can always start decoding the macroblock row, and consequently, each macroblock in the row. Thus, use of macroblock rows provides an unexpected results over just macroblocks. The unexpected results are evidence of the non-obviousness of adding "macroblock rows" to Piazza and Vartti, notwithstanding the teachings of Lee.

Accordingly, Assignee respectfully requests withdrawal of the rejection to claims 9, 12, and claim 23.

Conclusion

For at least the foregoing reasons, each of the pending claims is in a condition for allowance. Examiner is requested to pass this case to issuance.

Please charge any required fees not paid herewith or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Respectfully submitted,



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